

REMARKS

In the office action of Paper No. 20, Claims 13-16, 19, 20, 23, and 26-28 were allowed.

Claims 41-43 were objected to for depending from rejected base claims, but were indicated as being allowable if amended into independent form incorporating all of a subject matter of their base claim and any intervening claims.

Claim 41 has been amended herein to include all of the subject matter of its base Claim 29 and the one intervening Claim 40. It is therefore respectfully submitted that amended Claim 41, and Claims 42 and 43 that depend from amended Claim 41, are allowable over the prior art.

Claims 29-40 and 44 have been rejected.

Claims 29-32, 34, 36-40 and 44 were rejected for obviousness-type double patenting in view of Claims 34, 35, 40-42, 50-55, 57-61, 63 and 64 of co-pending application Serial No. 09/949,401. A terminal disclaimer is being submitted herewith that disclaims the life of a patent issuing from this application that would extend the life of any patent issuing from the 09/949,401 application. It is respectfully submitted that the terminal disclaimer submitted herewith overcomes the basis for the obviousness-type double patenting rejection.

Claims 29, 30, 34, 40 and 44 were rejected under 35 U.S.C. § 103(a) as being obvious in view of the U.S. Patent of Aoyagi no. 4,032,679. It is respectfully submitted that the subject matter of the rejected claims is substantially different from the subject matter disclosed in the Aoyagi reference, and that the claimed subject matter would not be obvious to the ordinary skilled artisan in view of the Aoyagi reference.

Of the rejected claims, Claim 29 is the only independent claim.

Claim 29 recites a printable form comprising a transparent patch layer, an adhesive layer secured to a bottom surface of the patch layer, a form having a top surface removably attached to a bottom surface of the adhesive layer whereby the patch layer is removably attached to the form layer top surface, a die cut through the form layer defining one form layer portion within the

die cut, where the adhesive layer has a greater affinity for the patch layer than the form layer whereby the patch layer and adhesive layer can be removed from the form layer with the one form layer portion attached to the adhesive layer.

The construction of the printable form described in Claim 29 and set forth above enables the patch layer to be removed from the form layer with the one form layer portion held to the patch layer by the adhesive layer. This enables the form layer portion to be used as a label by attaching the transparent patch layer that has been removed from the form layer to another object. In order to function as a label, the patch layer must be transparent so that any written subject matter on the one form layer portion that is removed from the form layer with the patch layer can be observed through the transparent patch layer when the patch layer is used as a label.

In contrast to the transparent patch layer recited in Claim 29, the Aoyagi reference discloses a sticker comprised of a sheet 21 that is divided by a die cut 24 into a round clipping 21a and an annular piece 21b. The clipping 21a and annular piece 21b are held to a piece of release paper 23 by an adhesive layer 22. The release paper 23 is provided only to prevent granular particles, such as the granular cleaner used as an example in the reference, from sticking to the adhesive. It is not necessary that the sheet 21 be transparent for this purpose.

Furthermore, in the first example of the sticker disclosed in the Aoyagi reference, the clipping 21a and the annular piece 21b are stuck independently to separate surfaces. The Aoyagi reference provides the example of sticking the clipping 21a on an invoice, for example an invoice for pharmaceuticals and sticking the annular piece 21b on a packaging of the pharmaceuticals. This enables collating the annular piece 21b on the packaging with the clipping 21a on the invoice to ensure that the proper pharmaceuticals have been shipped to the recipient. In this use of the sticker, the release paper 23 is completely removed from the clipping 21a and the annular piece 21b. There is no need for the clipping 21a or annular

piece 21b to be transparent to view what is printed on the release paper 23, because the release paper 23 is removed and discarded in use of the sticker.

Thus, in the examples of the use of the sticker provided by the Aoyagi reference, there is no motivation for constructing the sticker 21 of a transparent material. In view of this, the ordinary skilled artisan would not be motivated to construct the Aoyagi sheet 21 of a transparent material, and such a modification of the sheet would not be obvious. For this reason, it is respectfully submitted that Claim 29 and its dependent Claims 30-40 and 44 are allowable over the prior art.

Claim 33 was rejected in view of the Aoyagi reference, and further in view of the U.S. Patent of Jameson no. 4,910,058. The Jameson reference is relied on for a disclosure of a continuous patch layer with no die cuts through the patch layer. The Jameson reference does not overcome the short-comings of the Aoyagi reference set forth above, i.e., constructing the patch of a transparent material. For the same reason set forth above with regard to Claim 29, it is respectfully submitted that Claim 33 is allowable over the prior art.

Claims 35-39 were rejected in view of the Aoyagi reference and further in view of the US Patent of Popat et al., no. 5,662,976. The Popat reference was relied on for a disclosure of a patch layer, an adhesive layer, and an attached form layer portion that together form a fold-over card. The reference was not relied on for a disclosure of a transparent patch layer. For the same reasons set forth above with regard to Claim 29, it is respectfully submitted that Claims 35-39 are allowable over the prior art.

It is respectfully submitted that because the Aoyagi reference provides no motivation to the ordinary skilled artisan to construct a patch layer of a transparent material, the transparent patch of Claim 29 and its dependent Claims 30-40 and 44 is not obvious in view of the Aoyagi reference alone or in combination with the secondary references cited in the rejections of these claims, and the claims are allowable over the prior art.

It is respectfully submitted that in view of the amendments and remarks presented herein, the application is in condition for allowance and favorable action is requested.

Respectfully submitted,
Thompson Coburn LLP

By: Joseph M. Rolnicki
Joseph M. Rolnicki
Reg. No. 32,653
One US Bank Plaza
St. Louis, MO 63101-1693
(314) 552-6286